

Remarks/Arguments:

A substitute specification, both marked up and clean versions, accompanied by the requisite Rule 125 statement, is concurrently filed herewith. The substitute specification is submitted in order to be commensurate with the aforesaid amendments to claims 6 and 7 (with respect to the claims rejection, discussed below), i.e., by changing the word "inductance" to read "induction coil"; which, as readily appreciated by application figure 1, elements 3 and 4 are, indeed, induction coils, which form part of an electrical resonant circuit.

The objection to claims 6 and 7 is overcome, by changing the word "inductance" to recite "induction coil" (as explained, above, in connection with the amendments to the specification).

Claims 1-7 were rejected under 35 U.S.C. §103(a) for allegedly being obvious over DE 41 14 398 (Karlheinz) in view of U.S. Patent No. 3,200,399 (Gottfried). Reconsideration is requested.

Gottfried (column 2, lines 51-58) teaches: "In the receiver sections of both [transmit-receive] units, the received measuring wave is mixed with the transmitted measuring wave and, as a result, an oscillation with difference [*sic*] frequency is derived . . . the phase difference being dependent upon the distance between the two transmit-receive units." The mixing of the transmitted wave with the received wave is an indispensable feature of the distance measuring system (invention) according to Gottfried, enabling determination of the phase difference and, so, enables the skilled person to determine the distance. Also in the embodiment described in Gottfried column 1, lines 10-31, the distance is determined on the basis of the phase difference. Consequently, combination of Karlheinz and Gottfried would require a device where the distance is determined on the basis of a determined

phase difference. According to the presently claimed invention no use is made of phase difference for determining the distance. Therefore the combination of Karlheinz and Gottfried do not enable to obtain the presently claimed device.

According to the present, rejected claims a second, predetermined signal is used, which has a waveform representative of a signal to be picked up by the receiver. This second, predetermined signal is not met by the received signal in the measuring system invention according to Gottfried, since this second signal is not received by the receiver but, rather, as it is stored in the receiver.

Moreover, the second-signal feature (of the rejected claims) comprises a time window having a predetermined duration and comprising at least an initial sub-period, an intermediate period, and a final sub-period. No such second signal is disclosed or suggested by Gottfried, let alone a second signal characterized by an amplitude attenuated during the initial and final sub-periods and substantially at its maximum during the intermediate period. Such a second signal could not be obtained in the device according to Gottfried, as there are no teachings in the cited document to process the received signal in such a manner.

As such, the rejected claims are limited to a feature neither taught nor suggested in the combination of Karlheinz and Gottfried. That is, the combination of teachings does not meet (support) a second signal, as found in the rejected claims (which combination of references also requires a phase difference technique, which is not required in accordance with the invention provided by the rejected claims).

Moreover, rejected claims 3-4 are independently patentable as the rejection relies on unsupported allegations that a Tukey window or square waveform synchronization would be obvious modifications of the combined references teachings. "It is facts which must support the legal conclusion of obviousness." *Ex parte Crissy*, 201 USPQ 689, 695 (POBdApp 1976).

The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because *it* may *doubt* that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

In re Warner, 154 USPQ 173, 178 (CCPA 1967) (*emphasis original*). An argument by the PTO "is not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). When obviousness of a claim feature (limitation) is grounded on allegations the feature is "old and well known in the art," the "ground of rejection is simply inadequate on its face...because the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

Rejected claims 6 and 7 are, also, independently patentable, in that the rejection relies solely on a "well known...skill," *per se* (Office Action, page 4), possessed (allegedly) by the knowledgeable person in the art. When

the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at...[the claimed] invention because he had the necessary skills to carry out the requisite [claim features]...[t]his is an inappropriate standard for obviousness.

Ex parte Levengood, 28 USPQ2d 1300, 1301 (BPA&I 1993). "That which is within the capabilities of one skilled in the art is not synonymous with obviousness." *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993). "We have previously rejected the argument that

undirected skill of one in the pertinent art is an adequate substitute for statutory prior art." *In re Kratz*, 201 USPQ 71, 76 (CCPA 1979).

In view of the foregoing remarks, the rejection of claims 1-7 under §103(a) as allegedly being unpatentable over Karlheinz and Gottfried, is overcome. Withdrawal of the rejection is in order.

Claims 8-14 were rejected under 35 U.S.C. §103(a) for allegedly being obvious over Karlheinz and Gottfried and further in view of U.S. Patent No. 6,032,065 (Brown). Reconsideration is requested.

Even if, arguendo, Brown discloses a sensor mask as such, the combination of the sensor mask of Brown with the combined teachings of Karlheinz and Gottfried will not lead to the invention defined in the rejected claims, for the same reasons as set out, above, with respect to rejected claims 1-17. Moreover, Brown does not disclose a distance measuring device, as only a movement of the patient's mouth is sensed (Brown, column 3 lines 43-46). Sensing mouth movement does not measure the distance over which the mouth moved. Sensing as taught by Brown only detects mouth movement; it does not measure the distance over which the mouth moved. Moreover, the electrodes used by Brown (EEG, EOG and EMG) do not enable measurement. Consequently, a skilled person faced with a problem of measuring a distance over which a mouth was moved would not use the teaching of Brown, as the document does not disclose a measurement device. The totality of each reference's teachings must be considered when combining those teachings with the rest of the prior art. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986).

In view of the foregoing remarks, the rejection of claim 8-14 under §103(a) as allegedly being unpatentable over Karlheinz, Gottfried, and Brown, is overcome. Reconsideration is requested.

***Request for Grant of
Foreign Priority Under 35 USC 119***

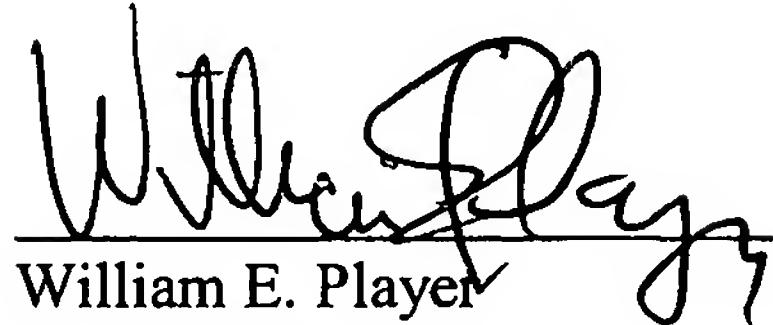
A claim to foreign priority under 35 USC 119 has been made (inventorship declaration of record) and the certified copy of the priority document received July 17, 2006 by the PTO, from the International Bureau (Notification mailed March 30, 2007 by the PTO).

Accordingly, request is made that the Examiner mark the next Office Action to acknowledge, both, the claim to §119 priority and receipt of the certified copy—by marking the appropriate boxes on the Office Action Summary sheet.

Attorney Docket No. P71376US0
Application No. 10/586,138

Favorable action is requested.

Respectfully submitted,



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